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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,151	03/06/2000	Manuel Zahariev	2222.9210001	7821

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WASHINGTON, DC 20005

EXAMINER

DONAGHUE, LARRY D

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2454

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/519,151	Applicant(s) ZAHARIEV, MANUEL	
	Examiner Larry Donaghue	Art Unit 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 44-66 are presented for examination.
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required .
3. The following lack antecedent basis in the specification : Original e-mail message and special e-mail address.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification set forth the following: “ In the embodiment described herein of the present invention, **when e-mail is received, a copy is typically forwarded to the customer's normal base address**. A copy is also retained on the server, which is then analyzed by the MailFilter code routine on line 110.”

The specification fails to support forwarding ... the original e-mail message to an e-mail address of the recipient.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 44,51,58-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Owens et al. (6,633,630).

As to Claims 44,51,58, and 59, Owens taught the invention (claims 44,51,58, 59) as claimed (claim 44) including the steps for receiving, using a processing device, an original e-mail message; producing, using the processing device, a copy of the original e-mail message; storing, using a memory, the copy (col. 3, lines 43-46, col. 12, lines 9-12) forwarding, using the processing device, the original e-mail message to an e-mail address of a recipient of the original e-mail message (col. 3, lines 43-46, col. 12, lines 9-12), analyzing, using the processing device, the copy to determine if a content of the copy matches a criterion stored in the memory; and sending, using the processing device, an alert message if the content matches the criterion (col. 3, lines 47-49, col. 12, line 14-18).\

As to claim 60, Owens et al. taught analyzing a characteristic of the copy with specific message characteristics stored in memory (col. 11, lines 62-66).

As to claim 61, Owens et al. taught the characteristic is located in sender information, subject line information, body information, or an attachment of the copy (col. 11, lines 62-66, elements are listed in the alternative, only one must be shown).

As to claim 62-63, Owens et al. taught the characteristic describes sender information, subject line information, body information, or an attachment of the copy (col. 11, lines 62-66, elements are listed in the alternative, only one must be shown).. As

to claim 63 , the characteristic identifies a size of the attachment, it is directed to further refinement of an unelected alternative.

As to claims 64-65, Owens et al. taught the mobile device comprises a phone or paging device (col. 12, lines 13-17).

As to claim 66, Owens et al. taught telephone menu system configured to allow performance of one or more of the following actions: logging in, identifying the e-mail message associated with the copy that matches the criterion, selecting from recorded options, and inputting information for forwarding the e-mail message associated with the copy that matches the criterion (col. 9, lines 38-60).

Claims 45- 50 and 52-59 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. as applied to claims 44 and 51 above, and further in view of Nielson et al. (6,108,688).

As to claims 45 and 52 Owens et al. taught producing, using the processing device, a new record for a first table stored in the memory; and sending, using the processing device, a pager message for the new record for the first table (Owens et al. taught and sending a pager message Figure 8, col. 12, lines 13-18, . Nielson et al. taught creating a record for a message Nielson et al. suggested using message id to allow for individual access and tracking of the messages in a database col. 3, lines 35-55 , would have been obvious to combine these teachings as both are directed to E-mail systems .

As to claims 46 and 53 , the alert message includes a unique identifier associated with the recipient (Owens et al. taught sending an alert (col. 12, lines 13-17, Nielson et al. suggested using message id to allow for individual access and tracking of the messages col. 3, lines 35-55 , would have been obvious to combine these teachings as both are directed to E-mail systems .

As to claims 47 and 54, Nielson et al. taught using the identifier as a lookup tool receiving, using the processing device, the unique identifier and a request for the copy; and sending, using the processing device, the copy (Nielson et al. taught using the identifier as a lookup tool receiving , Owens et al. taught requesting copy (col. 13, lines 46-48).

As to claims 48 and 55, Owen et al. taught the copy comprises an e-mail message and the sending the copy comprises sending, using the processing device, the e-mail message to a special e-mail address (Col. 9, lines 9-12, Owens et al. taught redirecting to any e-mail address which would included a special e-mail address).

As to claims 49 and 56, Owen et al. taught sending the copy comprises a facsimile message and the sending the copy comprises sending, using the processing device, the facsimile message to a telephone number associated with a facsimile machine (col. 12, lines 19-22).

As to claims 50 and 57 , are rejected for the same rationale as claims 45 and 52, and 49 and 56, claim appears to create a table for fax message the same as claims 45 and 52 perform for pager messages.

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4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry Donaghue whose telephone number is (571)272-3962. The examiner can normally be reached on Monday-Friday 9:00 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Donaghue/
Primary Examiner, Art Unit 2454